

Application No. 10/767,109
Amendment dated May 16, 2007
Reply to Non-Final Office Action of January 16, 2007

REMARKS

I. Introduction

Claims 1-26 are pending in the instant application. Claims 1-5, 7-13, and 16-26 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,251,611 to Zehel *et al.* (Zehel *et al.*); Claims 1-3, 5 and 7-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,837,846 to Jaffe *et al.* (Jaffe *et al.*); and Claims 1-3, 6, 9-11 and 16-20 stand rejected under 35 U.S.C. § 102(a) as being anticipated over U.S. Patent Appln. Pub. No. 2003/0130598 to Manning *et al.* (Manning *et al.*).

With this amendment, Claims 1-23 have been cancelled, Claims 24-26 have been amended to recite with more particularity that which Applicants consider as their invention, and Claims 27-44 have been newly added and depend from at least one of original Claims 24-26. The amendments and newly added claims are supported throughout the specification and the originally filed claims, and are, thus, appropriate for entry in the present application.

II. Rejections Under Section 102

A. Legal Standard

Anticipation under 35 U.S.C. § 102 requires that a single reference expressly or inherently disclose each and every element of a claim. *See e.g., In re Paulsen* 31 USPQ2d 1671, 1673 (Fed. Cir. 1994); MPEP § 2131 (citing *Brown v. 2M*, 265 F.3d 1349, 1351 (Fed. Cir. 2001)).

B. The Claimed Invention Is Not Anticipated By Zehel et al.

Independent claims 24, 25 and 26, as amended, require, in relevant part, the step of advancing an elongate body through a cavity towards tissue to be treated "while controlling said automatically controllable proximal portion of said elongate body with an electronic motion controller to assume said selected curve of said selectively steerable distal portion."

Zehel *et al.* teach a "flexible steerable exploratory device" having an inner flexible conduit 10 and an outer flexible conduit 11. Inner conduit 10 is slidably disposed within outer conduit 11. Zehel *et al.* also teach flexible distal end 12 as contiguous with and flexible with respect to outer conduit 11. Flexible distal end 12 is articulated with knobs 13.

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Zehel *et al.* lacks any description regarding an elongate body having a selectively steerable distal portion and an automatically controllable proximal portion. Because Zehel *et al.* does not describe such an elongate body he also lacks any description of a method of controlling the automatically controllable proximal portion with an electronic motion controller. As a result, Zehel *et al.* cannot anticipate any of the independent claims because each of the independent claims recites a limitation not disclosed by Zehel *et al.* For at least the reasons stated above Zehel *et al.* does not anticipate independent Claims 24-26. Newly added Claims 27-44 depend from at least one of independent Claims 24-26 and necessarily contain all the limitations of the claim(s) from which they depend. Therefore, for the same reasons stated above, Zehel *et al.* does not anticipate dependent Claims 27-44.

C. The Rejections Over Jaffe *et al.* Are Moot

Applicants have canceled Claims 1-3, 5 and 7-23, thereby rendering moot the rejection of these claims as being anticipated under 35 U.S.C. § 102(e) by Jaffe *et al.*

D. The Rejections Over Manning *et al.* Are Moot

Applicants have canceled Claims 1-3, 6, 9-11 and 16-20, thereby rendering moot the rejection of these claims as being anticipated under 35 U.S.C. § 102(a) by Manning *et al.*

E. Conclusion

It is respectfully submitted that Zehel *et al.* does not anticipate the claims of the present invention as originally drafted or as clarified by the present amendment for at least the reasons above. Additionally, the claims rejected over Jaffe *et al.* and Manning *et al.* have been canceled, rendering the rejection of these claims moot. Accordingly, Applicants respectfully request the rejections of Claims 24-26 under 35 U.S.C. § 102 be withdrawn.

III. CONCLUSION

It is respectfully submitted that Claims 24-26, as amended, and newly added claims 27-44 meet all of the requirements for patentability and are in condition for allowance. An early

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indication of the same is therefore kindly solicited. Should the Examiner have any question, the Examiner is encouraged to telephone the undersigned at (650) 212-1700.

Respectfully submitted,

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